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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,742	12/15/2000	Jason Hill	CUB-4 US	2149

34103 7590 02/26/2003

CUBIST PHARMACEUTICALS, INC.
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EXAMINER

LUKTON, DAVID

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/738,742

Applicant(s)

Hill

Examiner

David Lukton

Art Unit

1653



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 23, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5-12, 15-27, and 30-32 is/are pending in the application.
- 4a) Of the above, claim(s) 16-26 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-7, and 9 is/are rejected.
- 7) ☒ Claim(s) 8, 10-12, 15, 27, 31, and 32 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 6) ☐ Other:

Pursuant to the directives of paper No. 11 (filed 12/23/02), claims 5-8, 10, 15, 27, 30 have been amended, claims 3, 4, 13, 14, 28, 29 cancelled, and claims 31-32 added. Claims 1, 2, 5-12, 15-27, 30-32 are pending.

Applicants' election of Group V is acknowledged (claims 1, 2, 5-12, 15, limited to G3). The previous "species" election remains in force (compound #120, page 27). Claims 1, 2, 5-12, 15, 27, 31, 32 are examined in this Office action; claims 16-26 and 30 are withdrawn from consideration.

*

Claims 1 and 2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending application Serial No. 09/739,535. Although the conflicting claims are not identical, they are not patentably distinct from each other. There is overlap of the claimed genera.

[This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d)

*

Claims 5-7 and 9 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 5 recites that variable "R" can be the following: $-N(R^{13})CO-R^{200}$.

Claim 5 also recites that variable " R^{200} " can be hydrogen, heterocyclyl or heteroaryl.

However, none of these (hydrogen, heterocyclyl or heteroaryl) is permitted by claim 2, upon which claim 5 depends. It is noted that claim 5 is also dependent on claim 1, but that does not detract from its dependence on claim 2. Accordingly, the claim dependence (claim 5 on claim 2) is improper. Claim 5 also recites that variable " R^{200} " can be aryl; however, this possibility is precluded from claim 1. For this reason also, the claim dependence is not proper.

- In claim 9, a variable X^4 appears in one of the structures, but is undefined; at the same time, a variable "X" is defined, but does not appear in any of the structures.



It is suggested that claim 23 be amended to define all terms that are currently identified by trademark only. In addition, in the event that applicants provide a sequence for "PR39" (claim 23, fifth line from last), it is suggested that a CRF listing be provided.

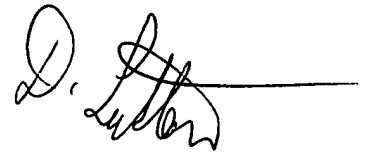
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 703-308-3213. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached at (703) 308-2923. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



DAVID LUKTON
PATENT EXAMINER
GROUP 1800